

## **REMARKS**

Applicants wish to thank the Examiner for the attention accorded to the instant application, and respectfully requests reconsideration of the application as amended.

### **Formal Matters**

In this Response, claims 1-9, 22-31, and 38 are pending. Claim 9 is amended to be an independent claim, including all of the limitations of its base claim and intervening claims. Claims 10-21, 32-37, and 39-48 have previously been withdrawn. Care has been taken to ensure no new matter is being entered.

### **Rejection of Claims Under 35 U.S.C. §102**

Claims 1-5, 7-8, 22-27, 29-30 and 38 are rejected under 35 U.S.C. §102(e) as anticipated by Finseth et al., U.S. Patent No. 6,813,775 (hereinafter "Finseth"). This rejection should be withdrawn based on the comments and remarks herein.

Finseth teaches a method and apparatus for sharing user preferences, that is, how a user can prepare a list of programs (viewing preferences) and share this list with one or more other viewers (column 1, lines 57-58). Initially, applicants respectfully disagree with the Examiner's assertion that the viewing preferences of Finseth teaches timer recording pattern information as recited in the claims of the present invention. Finseth discloses viewing preferences that can provide user specific program guide content, advertising and conditional channel content (column 12, lines 12-15). Finseth does not teach or suggest timer recording pattern information, that is, program identification codes that can be used in conjunction with an electronic program guide to obtain program start and end times (see specification, page 13, lines 25-27). Applicants are not attempting to impart limitations present in the specification to the element recited in

independent claims 1, 22, 23, and 38, but rather to give proper meaning to the claimed property of “timer recording pattern information”. It is proper to rely on the specification and drawings to determine the correct meaning of a term used in the claim language, as discussed in *Markman v. Westview Instruments*, 52 F.3d 967,980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1996).

Further, Finseth does not teach or suggest how this list is put to use; in particular, Finseth does not teach or suggest setting, on an automatic broadcast recording apparatus, timer recording for one of the broadcast programs using said timer recording pattern information, and receiving the program set for timer recording, and recording the received program, as recited in independent claim 1. The Examiner contends that Figure 4 of Finseth discloses “setting timer recording for one of the broadcast programs using said timer recording pattern information”. Applicants respectfully disagree. Figure 4 is a diagram of an electronic television program guide (column 2, lines 53-55). No teaching or suggestion is made on this figure (or elsewhere in Finseth) of timer recording or of setting timer recording for one of the broadcast programs using said timer recording pattern information. Thus Finseth does not disclose each feature of independent claims 1, 22, 23, and 38.

It has been held by the courts that “Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). As illustrated above, Finseth does not disclose timer recording pattern information from a server, or timer recording pattern information for recording broadcast programs recommended by at least one opinion leader, so that Finseth does not disclose every feature of the invention as recited in independent claims 1, 22, 23, and 38. Consequently, these independent claims are not anticipated by the art of record in the application.

Claims 2-5, 7, and 8 depend from claim 1, and claims 24-27, 29, and 30 depend from claim 23, each dependent claim incorporating all of the features and limitations of its base claim. Thus, these dependent claims are not anticipated by the art of record in the application for at least the reasons that their base claims are not anticipated by the art of record in the application. Accordingly, this rejection should be withdrawn.

### **Rejection of Claims Under 35 U.S.C. §103**

Claims 6, 9, 28 and 31 are rejected under 35 U.S.C. §103(a) as unpatentable over Finseth as applied to claims 1-5, and further in view of Okada, U.S. Patent No. 7,095,949. This rejection should be withdrawn based on the comments and remarks herein.

The Examiner acknowledges that Finseth does not teach or suggest “confirming the broadcasting date and time of a program to be recorded from said program information when the program information is acquired, and correcting the broadcasting date and time if the broadcasting date and time have been changed” as recited in claim 9. The Examiner alleges that Okada teaches this feature. Applicants respectfully disagree. Okada teaches a broadcast video image recording apparatus having a first and second storage unit for storing video image data to be played back (column 2, lines 26-28). In particular, Okada discloses view/playback based on a list generated based on how the user views and plays back broadcast programs (column 7, lines 13-26). Okada does not teach or suggest confirming a date and/or time of a program to be recorded from program information. Thus Finseth and Okada do not teach or suggest each feature of independent claim 9.

It has been held by the courts that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See, *In re Royka*,

490 F.2d 981, 180 USPQ 580 (CCPA 1974). As illustrated above, the hypothetical combination of Finseth and Okada does not disclose or suggest confirming a date and/or time of a program to be recorded from program information, and does not teach or suggest each and every feature of the present invention as recited in independent claim 9. Thus *prima facie* obviousness has not been established, so that claim 9 is patentably distinguishable over the art of record in the application.

Further, as discussed above, Finseth does not teach or suggest timer recording pattern information from a server. Okada does not overcome this deficiency and the Examiner does not state otherwise. As discussed above, Okada teaches a broadcast video image recording apparatus capable of recording video images that have been broadcast in the past. Okada does not teach or suggest a server and does not teach or suggest timer recording pattern information at a server. Hence, the hypothetical combination of Finseth and Okada does not teach or suggest each and every feature recited in independent claims 1 and 23 of the present invention, so that *prima facie* obviousness has not been established. Claim 6 depends from claim 1, and claims 28 and 31 depend from claim 23, each dependent claim incorporating all of the features and limitations of its base claim. Thus, these dependent claims are patentably distinguishable over the art of record in the application for at least the reasons that their base claims are patentably distinguishable over the art of record in the application. Accordingly, this rejection should be withdrawn.

### Conclusion

In light of the foregoing, Applicants respectfully submit that all pending claims recite patentable subject matter, and kindly solicit an early and favorable indication of allowability. If the Examiner has any reservation in allowing the claims, and believes a telephone interview would advance prosecution, he is kindly requested to telephone the undersigned at his earliest convenience.

Respectfully Submitted,



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